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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,132	01/28/2004	Remy Zimmermann	09623V-047600US	4300
20350 7590 10/17/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER ALVESTEFFER, STEPHEN D	
			ART UNIT 2173	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/767,132

Applicant(s)

ZIMMERMANN, REMY

Examiner

Stephen Alvesteffer

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9,11-22,24,25,27,28 and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9,11-22,24,25,27,28 and 30-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This Office Action is responsive to the amendment filed July 23, 2007. Claims 1, 4-8, 11-21, 24, and 27 are amended. Claims 3, 10, 23, 26, and 29 are cancelled. Claims 30-34 are new. Claims 1, 8, 15, 21, 24, and 27 are independent claims. Claims 1, 2, 4-9, 11-22, 24, 25, 27, 28 and 30-34 are currently pending.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4-9, 11-22, 24, 25, 27, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Walter et al. (hereinafter Walter), United States Patent Application number 2005/0156873.

**Regarding claim 1**, Walter teaches a system for mapping captured multimedia information onto graphics for insertion into a communication using an Instant Messaging (IM) application, wherein the insertion is based on multimedia information (see paragraph [0018]; "*users can create their own emoticons by adapting many sorts of image files to be custom emoticons*"), the system comprising an information capture

Art Unit: 2173

module for capturing the multimedia information in the vicinity of a machine on which the user is using the IM application (see paragraph [0028]; *"an image selector 308 captures an image and converts the image to an emoticon"*); an information extraction and interpretation module communicatively coupled with the information capture module, for extracting relevant information from the captured multimedia information and interpreting it (see paragraph [0027]; *"An exemplary CEE 206 includes a user interface 302 that may include a "define custom emoticons" module 304 and a "create text message" module 306. The exemplary CEE 206 also includes an image selector 308, a custom emoticons object store 310, and a transmitter 312, all communicatively coupled as illustrated"*); and a mapping module communicatively coupled with the information extraction and interpretation module, for mapping the interpreted information onto a graphic (see paragraph [0023]; *"An exemplary CEE 206 also performs real-time mapping from the text of a typed message to custom emoticons to be included, inserted, substituted, etc., into the message"*); an Application Program Interface module for the IM application, communicatively coupled to the mapping module, for inserting the graphic into the communication in real time using the IM application, said inserting only occurring after detecting a trigger from a user (see paragraph [0023]; *"In one implementation, each node 202, 204 includes an exemplary custom emoticon engine "CEE" (e.g., 206, 208). An exemplary CEE 206 allows a user to adopt an arbitrary image 210 as a custom emoticon. An exemplary CEE 206 also performs real-time mapping from the text of a typed message to custom emoticons to be included, inserted, substituted, etc., into the message"*; see also paragraph [0033]; *"a message*

*transmitter 324 may be employed to send the character sequence to a destination, i.e., within a communication such as an instant message. Each time the character sequence associated with a custom emoticon is used in a text message, a custom emoticon associated with the character sequence will be substituted for the character sequence at the destination, e.g., the receiving client 204", the user sending the instant message is the trigger for inserting the graphic).*

**Regarding claim 2**, Walter teaches that the multimedia information comprises at least one of audio information, still image information, and video information. Walter teaches that an emoticon can be an arbitrary image (see Abstract, first sentence).

**Regarding claim 4**, Walter teaches that the emoticon graphic is predefined by the IM application (see paragraph [0030]).

**Regarding claim 5**, Walter teaches that the graphic is predefined by a third-party application. In Walter, paragraph [0023], it is clear that the invention can be used in many different types of applications.

**Regarding claim 6**, Walter teaches that the graphic is created by the user (see paragraph [0018]).

**Regarding claim 7**, Walter teaches that the graphic is created by the user by processing captured multimedia information (see paragraph [0024]).

**Claims 8, 9, and 11-14** recite a method with substantially the same limitations as the system of claims 1, 2, and 4-7, respectively. Therefore, the claims are rejected under the same rationale. It should be noted that claims 11-13 refer to a plurality of

Art Unit: 2173

emoticons as opposed to a single emoticon, which Walter also anticipates in paragraph [0030].

**Claims 15 and 16** recite a method with substantially the same limitations as the system of claims 1 and 3, respectively. Therefore, claims 15 and 16 are rejected under the same rationale.

**Regarding claim 17**, Walter teaches storing the graphic for use in a later IM communication using the application (see paragraph [0030]).

**Regarding claim 18**, Walter teaches that the step of processing the received captured multimedia information to create a graphic comprises reducing the size of the captured multimedia information (see paragraph [0028]).

**Regarding claim 19**, Walter teaches that the step of processing the received captured multimedia information to create a graphic comprises reducing the resolution of the captured multimedia information (see paragraph [0028]). The resolution of the emoticon after reduction in size is inherently reduced.

**Regarding claim 20**, Walter teaches that the step of processing the received captured multimedia information to create a graphic comprises selecting a frame from a plurality of frames of the captured multimedia information (see paragraph [0049]).

**Claims 21 and 22** recite a system with substantially the same limitations as the system of claims 1 and 2, respectively. Therefore, the claims are rejected under the same rationale.

**Claims 24 and 25** recite a method with substantially the same limitations as the system of claims 1 and 2, respectively. Therefore, the claims are rejected under the same rationale.

**Claims 27 and 28** recite a system with substantially the same limitations as the system of claims 1 and 2, respectively. Therefore, the claims are rejected under the same rationale.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walter (2005/0156873) *supra* and Day et al. (hereinafter Day), United States Patent number 7,039,676.

**Regarding claim 30**, Walter teaches every limitation of claim 30 except that said graphic represents motion by said user. However, Day teaches a system that analyzes user motion to determine graphics to insert into real-time instant messages (see Day column 3 line 36 through column 4 line 2; "*The system, method and program of the invention automatically generates input into chat room software that represents an actual physical gesture made by a participant in a real time communication over a network, such as a "live" chat session or an instant messaging communication*"). It

Art Unit: 2173

would have been obvious to one of ordinary skill in the art at the time the invention was made to use the motion and gesture analysis system of generating emoticons of Day to generate the custom icons in the invention of Walter for the purpose of making it easier for users to generate custom emoticon graphics for transmitting over instant message sessions.

**Regarding claim 31**, Day teaches that said trigger is a gesture by said user (see Day column 3 line 36 through column 4 line 2; *"A video camera, utilized in connection with the participants' computer system, captures the real time gestures made by the participant, such as a wave, a shoulder shrug, a nodding of the head, and inputs the captured video images into the computer system of the participant"*, receiving a gesture is the action that triggers the system to generate an emoticon graphic).

**Regarding claim 32**, Day teaches that said relevant information extracted by said information extraction and interpretation module is in a non graphic format (see Day column 8 lines 16-26; *"since the configuration process has defined each gesture with a corresponding action, a database or table 300 (FIG. 3) becomes populated with the gesturing events 301, state of gesture 302, and corresponding action 303 and parameter of the action 304, i.e., the content to be transmitted for the gesturing event"*).

**Regarding claim 33**, Day teaches that said relevant information extracted by said information extraction and interpretation module is mapped to one of a preselected group of graphics, including graphics representing a smile, a frown and a wink (see Day column 7 lines 48-58; *"the automatic gesture software may provide a set of available gestures, e.g., wave hand, smile, frown, wink, shrug, nod, for which the user may*



*designate the action (announce, insert text, insert graphic,) and the parameter of the action (e.g., the content or translation of the gesture)").*

**Regarding claim 34**, Day teaches that said relevant information extracted by said information extraction and interpretation module is an article worn by said user (see Day column 6 lines 15-32; *"The imaging software analyzes various features of a participant from captured video frames generated by video camera 115. For example, the imaging software may discern any one or more of the following features including, but not limited to, the head, eyes, mouth (lips), shoulders, arms, and hands. For example, the imaging software can detect whether the head nods up and down in successive frames, or if there is a prolonged "wink" in one eye, or if the mouth makes a smile or frown, or if the shoulders "shrug", or if an arm or hand moves across the captured video frames such as in depicting a wave or other gesture"*, the imaging software described by Day is capable of detecting and interpreting articles worn by a user).

### ***Response to Arguments***

Applicant asserts that Walter does not teach graphics being inserted into a communication "in real time". The examiner respectfully disagrees.

In Walter paragraph [0023], Walter teaches *"An exemplary CEE 206 also performs real-time mapping from the text of a typed message to custom emoticons to be included, inserted, substituted, etc., into the message"*.

Art Unit: 2173

Applicant further asserts that Walter does not teach a "trigger" which initiates insertion of the graphic into the message. The examiner respectfully disagrees.

In Walter paragraph [0033], Walter teaches "*Each time the character sequence associated with a custom emoticon is used in a text message, a custom emoticon associated with the character sequence will be substituted for the character sequence at the destination, e.g., the receiving client 204*". The user sending the instant message is the trigger for inserting the graphic into the message.

The new claims introduce subject matter which the examiner believes would have been obvious in light of gesture-aware instant messaging applications that existed at the time the invention was made, such as the software taught by Day.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2173


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Alvesteffer whose telephone number is (571) 270-1295. The examiner can normally be reached on Monday-Friday 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571)272-4048. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Stephen Alvesteffer  
Examiner  
Art Unit 2173

  
TADESSE HAILU  
PRIMARY EXAMINER



10-11-2007